

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Arnold G. Slezak**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/981,556**
Filed: **October 17, 2001**
For: **METHOD TO REDUCE SERVO PATTERN RUNOUT ON A PREWRITTEN DISC**

Group Art: **3729**
Examiner: **Anthony D. Tugbang**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

THE OFFICE'S RATIONALE FOR ALL OF THE STANDING REJECTIONS IS
REVERSIBLE ERROR WHERE IT MISCHARACTERIZES WHAT THE *ALIGNMENT AXIS*
FEATURE OF CLAIM 1 REASONABLY MEANS

The Office's rationale for each of the standing rejections is in part based on its asserted interpretation of what the broadest reasonable interpretation is for the *alignment axis* feature of claim 1.¹

1. It is reversible error that the Office asserts an interpretation of an *alignment axis* feature of claim 1 separate from its contextual meaning in relation to the immediately preceding language *concentricity offset in a direction of...*

Appellant has shown that it is reversible error to attempt to ascertain some reasonable meaning of the claim term *alignment axis* that is divorced from its contextual meaning from the claim language as a whole, of which the term *alignment axis* forms a part.² Particularly, the skilled artisan reading the claim as a whole readily ascertains that the *alignment axis* feature defines the direction of the servo track concentricity offset: *each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis...*³

¹ Section 112 written description rejection: ppg. 9-11; Section 112 indefiniteness rejection pg. 12; Section 102 rejection ppg. 12-14.

² See Appellant's Brief pg. 13.

³ Excerpt of claim 1 (emphasis added).

The Office acknowledges its obligation to consider the claim as a whole, but then fails to do so by ignoring the immediately preceding language *concentricity offset in a direction of* in attempting to interpret the meaning of the *alignment axis* feature:

The examiner's claim construction was reasonable and was considered as a whole. The first part of Claim 1 recites:

Placing a plurality of prewritten discs, each prewritten disc having servo tracks characterized by a concentricity offset in a direction of ***an alignment axis that is in the same angular direction for all of the plurality of prewritten discs in relation to a center of the respective prewritten disc,*** around a motor hub...

The emphasis here for Claim 1 is the explicit relationship between the claimed "alignment axis" and the "center of the respective prewritten disc". As the examiner has stated, the specification nowhere provides a frame of reference regarding the claimed "alignment axis" because the specification does not define any alignment axis.⁴

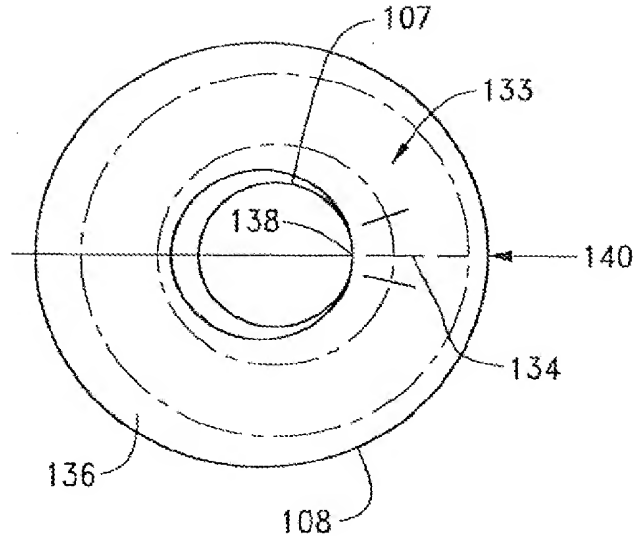
Appellant has shown that the plain meaning of the claim language, considered as a whole, explicitly defines the *alignment axis* feature as being in the direction of the servo track concentricity offset.⁵ Appellant has also shown that the skilled artisan having looked at FIG. 2 and the descriptions thereof in the specification readily ascertain support for the direction of the servo track concentricity offset, and hence provide a clear understanding of what direction the featured *alignment axis* is.

Reiterating, Appellant has shown that its FIG. 2 and the descriptions thereof clearly disclose a prewritten disc 108 having a servo track pattern (depicted by broken circles⁶) that defines a concentricity offset from the disc 108.

⁴ Examiner's Answer pg. 9.

⁵ See Appellant's Brief pg. 7 note 11.

⁶ See specification pg. 6:29-30.



That skilled artisan understands from the ordinary meaning of “concentricity offset” that the disc surface is concentric around its center, but the servo track pattern on the disc surface is concentric around a different point than the disc surface’s center. Incidentally, the skilled artisan understands that the point around which the servo track pattern is concentric is the hub 107 axis of rotation. The line from the point defining the disc surface center to the point defining the servo track pattern concentricity is a quantity the skilled artisan understands as being the featured *concentricity offset*. For example, disc surface center and the point around which the servo track pattern is concentric are the same point, then the distance between those two points is zero, meaning the servo track pattern is concentric in relation to the disc surface and, by definition, the concentricity offset is zero. However, in the embodiments of FIG. 2 above the servo track pattern clearly is not concentric in relation to the disc surface center, so there is a concentricity offset. The direction of that concentricity offset (direction of the line from the disc surface center to the point around which the servo track pattern is concentric) in the embodiments of FIG. 2 of the specification (above) is coextensive with the direction of the alignment mark 134.

The Office’s entire focus on interpreting the alignment axis in relation to the disc center, to the complete exclusion of the immediately preceding language explicitly defining the alignment axis as being the direction of the servo track concentricity offset, is reversible error for

effectively ignoring explicitly recited claim language. In fact, the Office has factually mischaracterized claim 1 by effectively rendering the language *servo tracks characterized by a concentricity offset in a direction of...* meaningless, or superfluous, effectively ignoring the patentability of the invention as claimed.⁷ Further, the Office's continued assertion that the specification allegedly "nowhere provides a frame of reference regarding the claimed "alignment axis""⁸ is reversible error for being a mischaracterization of what the specification clearly discloses to the skilled artisan.

2. It is reversible error that the Office asserts that the *concentricity offset in a direction of an alignment axis* feature of claim 1 is not limited to a line that is in a direction that is coplanar with the *servo tracks* feature of claim 1.

The skilled artisan readily understands two points define a line. The discussion above identified two such points, the disc surface center and the point around which the servo track pattern is concentric. Clearly, the skilled artisan readily ascertains that both of those points lie within the plane defined by the disc surface. Therefore, that skilled artisan understands that the featured *alignment axis*, as plainly defined by the claim language, is constrained to likewise lie within the plane defined by the disc surface.

The Office correctly states that the servo tracks are constrained to the plane of the disc surface:

Kuroba shows a plurality of prewritten discs (e.g. 20), each having servo tracks with a concentricity on the surface of the disc.⁹

The examiner reiterates that the servo patterns that are written on the discs of Kuroba are clearly on the surface of the disc between the inner and outer diameters of the disc....¹⁰

⁷ 37 CFR 1.104(a)(1): "The examination shall be complete with respect...to the patentability of the invention as claimed...."

⁸ Excerpt of the passage in note 4.

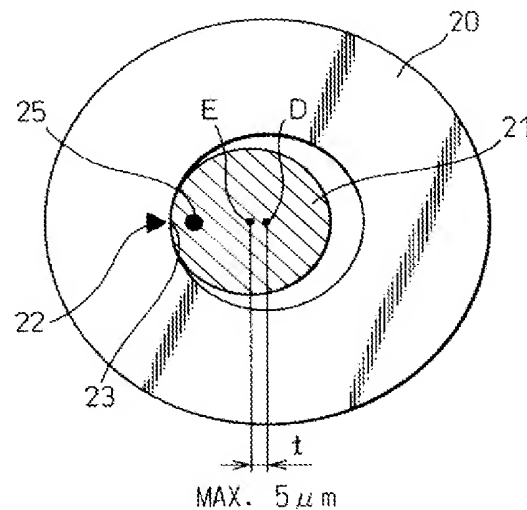
⁹ Examiner's Answer pg. 12.

¹⁰ Examiner's Answer pg. 14.

However, because the Office erroneously ignores claim language that explicitly defines the alignment axis as being the direction of the servo track concentricity offset, discussed above, the Office as a result also erroneously concludes that claim 1 can allegedly read on an alignment axis that is not coplanar with the disc.

The Office points to Kuroba's FIG. 4 for its stated rationale:

Fig. 4



This is the Office's newly stated rationale in its Examiner's Answer as to why the skilled artisan would allegedly agree that the featured *alignment axis* can be in a direction perpendicular to the disc surface, or in some other direction that is not in the same plane as the disc surface:¹¹

The prewritten disc (20) clearly has a center (e.g. D), in which an alignment axis can be drawn through this center that is perpendicular to the disc surface, or one that is into and out of the page of Figure 4, through D. The prewritten disc (20) additionally has servo tracks (written on the surface between the inner and outer diameters of the disc) characterized by one concentricity at reference marker 22, as one concentricity of the servo tracks can be taken at the inner diameter of the disc. An alignment axis taken at this concentricity of reference marker 22 is one that is drawn through the reference marker 22, again perpendicular to the surface

¹¹ Examiner's Answer pg. 12.

of the disc, or into and out of the page of Figure 4, through 22. So it is clear the claimed “alignment axis” of the concentricity of the servo tracks (through 22) is parallel and offset to the alignment axis of the center of the disc (through D), when both are perpendicular to the surface of the disc, so both would be in the “same angular direction.”¹²

Generally, the Office’s stated rationale does not substantiate evidence in terms of the explicit claim language itself. Instead, the Office chooses to slice and dice the claim language in bits and pieces that are then open to different and sometimes indiscernible meaning. That is, neither here nor anywhere else does the Office put together a cogent argument aimed at the claim language as a whole in interpreting the *alignment axis* as being entirely consistent with the claim language meaning of *each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis*.... Appellant believes the Board need not look beyond the Office’s refusal to address the claim language itself and as a whole to find reversible error.

Nonetheless, the Office first posits that an axis can pass through the disc center that is not coplanar with the disc surface. That is true enough, but the skilled artisan knows it takes at least two points to define a line (axis), so the fact that an axis can pass through the disc center in a direction non-coplanar with the disc surface is in-and-of itself irrelevant to understanding the broadest reasonable interpretation of the *alignment axis* feature.

The Office then attempts to define the second point in terms of the reference marker 22. However, Appellant has tried but admittedly cannot discern any logical basis for this excerpt of the Office’s argument above:

The prewritten disc (20) additionally has servo tracks (written on the surface between the inner and outer diameters of the disc) characterized by one concentricity at reference marker 22, as one concentricity of the servo tracks can be taken at the inner diameter of the disc. An alignment axis taken at this concentricity of reference marker 22 is one that is drawn through the reference marker 22, again perpendicular to the surface of the disc, or into and out of the page of Figure 4, through 22.¹³

¹² Examiner’s Answer ppg. 12-13 (emphasis added).

¹³ Excerpt of passage at note 12 (emphasis added).

The skilled artisan understands the ordinary meaning of “concentricity” is “having a common center.”¹⁴ The skilled artisan readily ascertains the Office’s rationale is erroneous because clearly there is no servo track that is concentric to Kuroba’s reference marker 22. Plainly rebutted, the skilled artisan understands that Kuroba does not teach “servo tracks...characterized by one concentricity at reference marker 22” as stated by the Office in its newly stated rationale.

Using the Office’s reference, the skilled artisan readily ascertains that the alignment axis, in terms of the two points D (disc surface center) and E (point around which servo tracks are concentric) discussed above clearly define the magnitude of the featured *concentricity offset*, and the direction of the *concentricity offset* defines the direction of the featured *alignment axis*. Importantly, again, both of the two points that define the concentricity offset are within the disc surface plane, and those two points define a line. The direction of that line, according to the plain meaning of the claim language as a whole, defines the direction of the featured *alignment axis*.

For these reasons, the featured alignment axis is by definition a line that lies within the plane defined by the disc surface, where the Office agrees the servo tracks are. The Office’s rationale that other axes not constrained to the plane defined by the disc surface can allegedly teach the featured *alignment axis* is reversible error for being wholly unsubstantiated by any factual evidence that withstands the scrutiny of the skilled artisan.

There are multiple passages in the Examiner’s Answer in which the Office’s rationale relies on this reversible error. Note that in each passage the Office even admits (emphasized by **underline and bold text**) that its asserted interpretation of the *alignment axis* feature is inconsistent with the disclosure of the specification.

In utilizing the ordinary, plain meaning of the claim language, each respective prewritten disc certainly has a center in which an

¹⁴ <http://www.merriam-webster.com/dictionary/concentricity>

alignment axis of the disc passes through this center that can be perpendicular to the disc. While it is clear that each prewritten disc has servo tracks defined by a particular concentricity on each disc, the claimed “alignment axis” can be read as one in which the direction is perpendicular to the concentricity of the servo tracks on the disc as this is in the same angular direction (i.e. a direction perpendicular to the upper or lower flat surface of the disc, or parallel, to the alignment axis that passes through the center of the disc. As such, the claimed “alignment axis” is parallel and offset from the alignment axis that passes through the center of the disc. This claim construction by the examiner is merely using the plain ordinary meaning of the claim and is problematic for the appellant because **such an interpretation is not supported by the specification.** For the appellant to argue that the features of the claimed “alignment axis” can “only be limited to the direction of the servo track concentricity on the surface of the disc”, or that it “must be in the same plane, as the disc plane, or disc surface”, or “coextensive with an alignment mark on the disc surface”, is insignificant to the extent that the claims do not recite any of these features. The appellant is arguing much more specifically than that which is claimed. Again, the specification provides no explicit definition as to what is considered to be an “alignment axis.”¹⁵

Furthermore, in reading that the “respective alignment axis” can be one that is perpendicular to the disc (as previously discussed), or in a plane that is not parallel to a main disc surface, the specification provides no such support for any application of symmetrical forces in directions that are not parallel to the surface of the disc.¹⁶

Moreover, by interpreting the “alignment axis” as one that is perpendicular to the disc surface, or in a direction that is not in the same plane as the main disc surface, would again render claim language as indefinite because **these two interpretations would contradict the specification.**¹⁷

The rules of the PTO require that application claims must conform to the invention as set forth in the remainder of the specification and the claim language must find clear support in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.¹⁸ Thus, during examination claims are given their broadest reasonable

¹⁵ Examiner’s Answer ppg. 9-10.

¹⁶ Examiner’s Answer pg. 11.

¹⁷ Examiner’s Answer pg. 12.

¹⁸ *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005)(en Banc), quoting 37 C.F.R. § 1.75(d)(1).

interpretation consistent with the specification.¹⁹ The broadest reasonable interpretation is the meaning that the skilled artisan would give to the claim term in view of the associated usage provided in the specification.²⁰ A construction that is inconsistent with the written description would not be arrived at by the skilled artisan, and is therefore not a reasonable interpretation.²¹

The Office's asserted interpretation that the *alignment axis* feature of claim 1 does not necessarily lie within the plane defined by the disc surface is, for reasons above including the Office's own admission, inconsistent with the clear disclosure of the specification and therefore reversible error for not being within the broadest reasonable interpretation consistent with the specification.

3. It is reversible error that the Office asserts that the featured *alignment axis* and the disclosed alignment mark are not necessarily coextensive.

The Office in its Examiner's Answer continues to make a factually unsubstantiated assertion that the embodiments of FIG. 2 do not disclose the alignment axis feature of claim 1:

Figure 2 and the description of it by the specification, describe the appellant's invention in reference to alignment marks, not any alignment axes.²²

Appellant has shown, without rebuttal by the Office, that the disclosure of the filed application clearly discloses embodiments differing from those depicted by FIG. 2 in that they do not employ the physical indicia in the form of the alignment mark 134.²³

Reiterating briefly, as seen above in FIG. 2, the skilled artisan readily ascertains that in those depicted embodiments the direction of the featured *alignment axis* is coextensive with the direction of the alignment mark 134, because both define the direction of the servo track

¹⁹ *Phillips, supra*; MPEP 2111

²⁰ *In re American Academy of Science Technical Center*, 70 USPQ2d 1827 (Fed. Cir. 2004); *In re Cortright*, 49 USPQ2d 1463, 1468 (Fed. Cir. 1999); *In re Morris*, 44 USPQ2d 1023 (Fed. Cir. 1997)

²¹ *Phillips, supra*; *In re Morris, supra*; *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

²² Examiner's Answer pg. 12.

²³ Appellant's Brief ppg. 7-8.

concentricity offset. Appellant has also repeatedly shown²⁴ that the skilled artisan having read the specification understands that only in some embodiments is it necessary to employ the alignment mark 134 as a physically existent indicia on the disc.²⁵ Reiterating, the specification explicitly discloses it to be advantageous to produce the concentricity offset in mere relation to a radial axis, the *alignment axis*, without any need to employ physical indicia on the disc visually marking the *alignment axis*:

In yet another preferred embodiment, no alignment mark is placed on the prewritten disc at all. After the servo information has been written to the disc, the position of the disc is precisely monitored relative to the biasing forces used during servo write and placed in a carrier for storage.²⁶

The skilled artisan having read the specification understands that the featured *alignment axis* in all embodiments is defined by the radial axis along which the biasing force was applied to the disc during servo write, because the biasing results in the servo track concentricity offset. Thus, the skilled artisan understands that the *alignment axis* exists in all embodiments where a concentricity offset exists, whether the physical indicia alignment mark 134 is employed or not. The skilled artisan understands that the alignment mark 134 is merely a physical manifestation of the featured *alignment axis*. The skilled artisan thus readily discerns that the featured *alignment axis* in fact does correlate to the alignment mark 134 for being in coextensive directions in those embodiments employing the physical indicia alignment mark 134. The Office's rationale that the *alignment axis* allegedly does not correlate to the alignment mark is reversible error.

THE OFFICE'S RATIONALE FOR THE SECTION 112 WRITTEN DESCRIPTION
REJECTION OF CLAIM 1 IS REVERSIBLE ERROR WHERE IT ERRONEOUSLY
ALLEGES THAT THE *ANGULARLY DISPOSED SYMMETRICALLY* FEATURE OF CLAIM 1
DEPARTS FROM THE DISCLOSURE OF THE APPLICATION

²⁴ Applicant's Pre-Brief Request of 2/15/2011 pg. 2; Applicant's Response of 1/18/2011 pg. 9; Applicant's Response of 8/23/2010 pg. 10; Applicant's Response of 5/24/2010 ppg. 1-2.

²⁵ See specification pg. 8:4-5.

²⁶ See specification pg. 8:12-15 (emphasis added).

The Office newly asserts a rationale in its Examiner's Answer that the claimed subject matter is susceptible to a written description rejection in accordance with MPEP 2163.02:

The appellant first urges that the 112, first paragraph rejection lacks merit because the appellant has demonstrated that the written description requirement supports the features surrounding the terms of “angularly disposed” and “symmetrically” and the requirement of *in haec verba* is not needed (pages 5 and 6 of the brief).

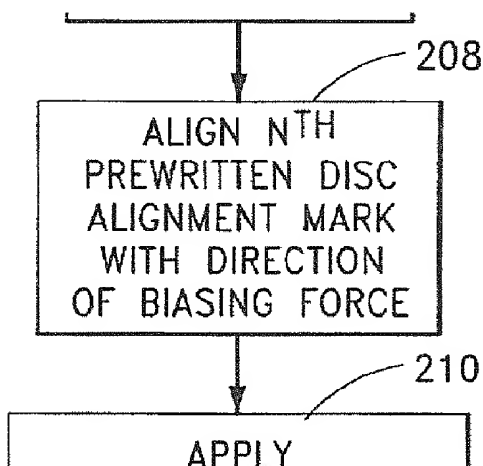
The examiner's position is not unreasonable because in reviewing the specification as a whole, these features are nowhere recited. During prosecution, Claim 1 was amended to include these features and the addition of these limitation surrounding these features depart from the disclosure of the application as filed (MPEP 2163.02).²⁷

The disputed language of claim 1 in context (surrounding the terms of “angularly disposed” and “symmetrically”) is *placing a plurality of prewritten discs...around the motor hub with respect to each other so that the alignment axes among the plurality of prewritten discs are angularly disposed symmetrically around the motor hub....*

Appellant has shown that the disputed claim feature is clearly supported in the disclosure of the application.²⁸ Reiterating briefly, Appellant has already shown that FIG. 2 above depicts the prewritten disc 108 being biased against the motor hub 107 by a biasing force 140 in the direction of the *alignment axis*. The prewritten disc has been positionally rotated to radially align the *alignment axis* (in these embodiments also the alignment mark 134) with the direction of the biasing force 140. This process is described in the alignment step in block 208 of the method depicted in FIG. 3:

²⁷ Examiner's Answer ppg. 8-9.

²⁸ See Appellant's Brief ppg. 10-12.



Appellant has also already shown that the direction of the biasing force (such as biasing force 140) is disclosed as being that which advantageously balances the plurality of discs that form a disc stack:

In an embodiment of a disc stack assembly having multiple prewritten discs 108, it is desirable to balance the disc stack assembly for rotation about the spindle motor hub 107. For disc stack assemblies with even numbers of discs, this may be accomplished by applying the biasing force for a particular disc in an opposite direction from any disc above and below that particular disc. For disc stack assemblies with odd numbers of discs, the biasing force should be applied to each disc at even angular intervals about a circumference of the discs 108. For example, if there are three discs, the biasing force for any particular disc should be applied to the outer diameter of the particular disc 108 one-hundred-twenty degrees apart from the direction of each of the biasing forces applied to the remaining two discs 108.²⁹

Based on the skilled artisan's understanding of the broadest reasonable interpretation of the featured *alignment axis* (and plurality of *alignment axes*), that skilled artisan having read the specification readily understands that placing the *alignment axes...angularly disposed symmetrically around the motor hub* plainly includes placing them oppositely (180 degrees apart) in a stack of even number of discs, and also includes placing them at even angular intervals (such as 120 degrees apart for three discs) in a stack of an odd number of discs.

By all this evidence Appellant has shown in the record that the skilled artisan finds clear support in the disclosure of the application that each disc is biased in the direction of its

²⁹ Specification pg. 8:20-30 (emphases added).

respective *alignment axis*, and that the biasing is done in an angular symmetrical manner for two or more discs in order to balance the mass of the disc stack. The skilled artisan readily understands that clearly supports the *alignment axes among the plurality of prewritten discs are angularly disposed symmetrically around the motor hub* feature of claim 1.

The Office's rationale for the written description rejection relies on MPEP 2163.02 which states in pertinent part:

If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application.³⁰

Against Appellant's evidentiary showing that the *alignment axes...are angularly disposed symmetrically around the motor hub* is clearly included in the disclosure of the application as filed, the Office's rebuttal (despite the showing of explicit disclosure that two alignment axes are disposed 180 degrees apart or that three alignment axes are disposed 120 degrees apart) is that support for the *angularly disposed symmetrically* feature is "nowhere to be found in the disclosure":

In regards to the features of "symmetrically", Claim 1 goes on to further recite:

The prewritten discs placed around the motor hub with respect to each other so that *the alignment axes among the plurality of prewritten discs are angularly disposed symmetrically around the motor hub...*

The examiner acknowledges that the specification clearly provides support for a plurality of prewritten discs being placed around the motor hub with respect to each other. Support can be said to be there also for placement of the prewritten discs such that each is angularly disposed relative to each other. However, the specificity of each being placed in a symmetric manner, or angularly disposed symmetrically, around the motor hub is nowhere to be found in the disclosure.

³⁰ Excerpt of MPEP 2163.02 (emphasis added).

The appellant further argues that the direction of the biasing forces are applied symmetric ally because the appellant believes that their specification discloses that the biasing forces for a particular disc can be applied in an opposite direction from any disc above and below that particular disc, or at even intervals about a circumference of the disc (page 11 of the brief).

For this part of Claim 1, the biasing is recited as:

after the placing step, biasing each of the plurality of prewritten discs in a direction of the respective alignment axis to concentrically align the servo tracks of a first disc of the plurality of prewritten discs with the servo tracks of a second disc of the plurality of prewritten discs.

The examiner acknowledges that the appellant's specification defines the biasing aspects in relation to "alignment marks" and that these biasing forces may be applied in different directions to the disc. However, this does not imply that the biasing forces are applied symmetrically. While the specification may provide one example of one biasing force at a certain angle from another biasing force, **a whole host of scenarios can occur in which the biasing forces are applied in different directions from one another that are certainly not symmetrical.**

Against all of Appellant's evidence that the disputed claim subject matter is contained in the disclosure of the application, the Office's newly stated rationale in its Advisory Action is even though symmetrical angular dispositions are disclosed (two discs 180 degrees apart or three discs 120 degrees apart), the Office contends that other angular dispositions are possible that are not disclosed by the specification.

Again, the rules of the PTO require that application claims must conform to the invention as set forth in the remainder of the specification and the claim language must find clear support in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.³¹ Thus, during examination claims are given their broadest reasonable interpretation consistent with the specification.³² The broadest reasonable

³¹ *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005)(en Banc), quoting 37 C.F.R. § 1.75(d)(1).

³² *Phillips, supra*; MPEP 2111

interpretation is the meaning that the skilled artisan would give to the claim term in view of the associated usage provided in the specification.³³ A construction that is inconsistent with the written description would not be arrived at by the skilled artisan, and is therefore not a reasonable interpretation.³⁴

The Office's written description rejection is reversible error because it is based on asserting an interpretation for the disputed claim phrase *angularly disposed symmetrically* that is inconsistent with the disclosure of the specification and thereby not within the broadest reasonable interpretation of the specification.

THE OFFICES RATIONALE FOR THE SECTION 102 REJECTION IS REVERSIBLE
ERROR WHERE IT ASSERTS THAT KUROBA'S WEIGHT 25 DISCLOSES THE BIASING
FEATURE OF CLAIM 1

The Office newly asserts in its Examiner's Answer a rationale that Kuroba's weight 25 (see Kuroba's FIG. 4 above) allegedly discloses the *biasing each of the plurality of prewritten discs in a direction of the respective alignment axis to concentrically align the servo tracks of a first disc...with the servo tracks of a second disc...* feature of claim 1:

Furthermore, biasing of the prewritten discs occurs by applying a biasing force (e.g. weight 25) for each disc at a location relative to the alignment axes of the center of the disc and concentricity of the servo tracks. The placement of this weight has one component of force that biases in a downward direction (through 25, perpendicular to the disc surface) that is in a direction parallel to the respective alignment axes (e.g. through 22) to concentricity.³⁵

The plain meaning of the disputed claim language is that the biasing feature is applied to each disc in a direction of its alignment axis. The Office's rationale is reversible error for the reasons discussed above because it asserts that Kuroba's weight 25 asserts a force in a direction of an alleged alignment axis that is perpendicular to the disc surface; that interpretation of the

³³ *In re American Academy of Science Technical Center*, 70 USPQ2d 1827 (Fed. Cir. 2004); *In re Cortright*, 49 USPQ2d 1463, 1468 (Fed. Cir. 1999); *In re Morris*, 44 USPQ2d 1023 (Fed. Cir. 1997)

³⁴ *Phillips, supra*; *In re Morris, supra*; *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

³⁵ Examiner's Answer pg. 13.

featured alignment axis is in error for not being within the broadest reasonable interpretation as discussed above. More generally, the skilled artisan readily understands that Kuroba's weight 25 is for the purpose of rotationally balancing the eccentric mass.³⁶ That skilled artisan readily understands that Kuroba's weight 25 does not disclose biasing each disc in a direction of the alignment axis as featured by claim 1.

The Office's rationale for the rejection is reversible error.

THE OFFICE'S REBUTTAL IN ITS EXAMINER'S ANSWER MISSES THE POINT OF APPELLANT'S REMARKS IN ITS APPEAL BRIEF TRAVERSING THE SECTION 102 REJECTION

The Office's rebuttal remarks characterize Appellant's rationale as being misplaced for allegedly arguing that claim 1 features writing the discs simultaneously:

The appellant appears to be saying Kuroba does not meet the above limitations because Kuroba writes the servo tracks on the discs individually and in different directions with respect to the contact positions against the motor hub (pages 17 and 18 of the brief). These arguments, while carefully considered by the examiner, appear to be misplaced to the extent that the claims never require that the servo tracks on the discs be written "simultaneously" and it appears that the appellant is arguing much more specifically than that which is claimed. The claims do not exclude Kuroba from writing servo patterns on the discs individually.³⁷

Although claim 1 does feature *placing a plurality of discs...*, Appellant did not assert that the claims feature writing the plurality of discs simultaneously. Appellant regrets any confusion its presented arguments may have created in this regard. In the context of Appellant's remarks, the mention that the discs could be written simultaneously was offered merely as an advantageous benefit of the claimed embodiments stemming from the claim feature that each of

³⁶ See Kuroba col. 8:4-30.

³⁷ Examiner's Answer ppg. 13-14 (emphasis added).

the plurality of discs has its respective alignment axis oriented in the same angular direction.

That passage excerpt is as follows:

For example, without limitation, in a three-disc stack all of the discs have servo tracks written to them concentrically offset in the same direction, such as in the zero degree direction of the alignment mark depicted in FIG. 2. That advantageously permits writing the servo tracks to all three discs in one setup, and even writing the servo tracks to all three discs simultaneously.³⁸

The simultaneous writing benefit false-issue raised by the Office aside, the substantive point of Appellant's traversal of the Section 102 rejection is that Kuroba does not disclose at least the *each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs...* feature of claim 1.³⁹ The salient point of Appellant's argument set forth previously in its Appeal Brief, incorporated herein in its entirety, is that because Kuroba expressly requires writing the different contact positions individually, those individually different set(s) of disc(s) are each written with the alignment axis disposed at the respective different angular direction. As Appellant stated in its Appeal Brief, the skilled artisan recognizes that the featured *concentricity offset of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs...* language of claim 1 **specifically excludes** what Kuroba discloses.

The Office's rationale for the Section 102 rejection is reversible error for not showing that Kuroba identically discloses all the features recited by the language of claim 1.

³⁸ Appellant's Brief pg. 17 (emphasis added).

³⁹ Appellant's Brief ppg. 15-18 (emphasis added).

Conclusion

For these reasons in addition to and further clarifying those reasons set forth Appellant's Appeal Brief which is incorporated by reference in its entirety, Appellant respectfully requests that the Board reverse the final rejection of claim 1 and the claims depending therefrom.

Respectfully submitted,

By: /Mitchell K. McCarthy/
Mitchell K. McCarthy, Registration No. 38,794
McCarthy Law Group
512 Northwest 12th Street
Oklahoma City, Oklahoma 73103
www.mccarthyiplaw.com
1.877.6546652 or 405.639.3082